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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/812,108

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Venkata A. Bhagavatula

SP00-095

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03/09/2006

CORNING INCORPORATED

SP-TI-3-1

CORNING, NY 14831

EXAMINER

PRASAD, CHANDRIKA

ART UNIT

PAPER NUMBER

2839

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/812,108	<b>Applicant(s)</b> BHAGAVATULA ET AL.	
	<b>Examiner</b> Chandrika Prasad	<b>Art Unit</b> 2839	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to amendments***

1. The reply filed 2/7/06 consists amendments to a number of claims and remarks related to rejection of claims. The claims are not allowable as explained below.

### ***Claim Objections***

2. Claims 43-53 are objected to because of the following informalities: the status of the claims are wrong.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-13, 18-36, 41 and 46-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiji (JP 54066152).

Seiji (Figures 1-6) shows an optical waveguide lens comprising an optical waveguide 13 and a lens member 10 with a spherical lens portion 11 and a throat portion 12 having a cross-sectional dimension greater than that of the optical waveguide. The waveguide has a core and a cladding is inherent. Seiji further shows a ferrule with a bore for receiving the waveguide. Seiji further teaches a method of making the lens and used in a passive, active optical components such as switch component or router, multiplexer, demultiplexer, etc.

Seiji shows all the features of these claims except lens made integral with the waveguide, the material of the lens member and the core of the waveguide, and dimensions of the waveguide. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to make the lens integral with the waveguide and the lens member of 4 weight percent borosilicate, having a softening point less than that of the core of the waveguide of various sizes, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In re Leshin, 125 USPQ 416. Furthermore, a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955), and forming in one piece an article formerly made in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 US 164 (1893).

5. Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebduska (4078852).

Lebduska shows a first, a second and a third waveguide with spherical lenses disposed on three faces of a birefringent material wherein the a throat portion of the lens has a diameter greater than the diameter of the waveguide but does not show two waveguides disposed on the same face. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to provide such a feature since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japiske, 86 USPQ 70.

6. Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebduska (4078852).

Lebduska shows all the features of these claims except the material of the lens member and the core of the waveguide. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to make the lens of borosilicate glass material with a softening point less than that of the core of the waveguide, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In re Leshin, 125 USPQ 416.

7. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konno et al. (5293438) in view of Lynch et al. (4844580).

Konno shows a waveguide attached to a lens member with a throat having a cross-section dimension greater than that of the wave guide but does not show another similar waveguide connected to the throat. Lynch shows two similar waveguides spaced apart, each with a lens member with a throat portion. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to attach a second waveguide because this would require a mere duplication of essential parts, which involve only routine skill in the art as shown by Lynch. St. Regis Co. vs. Bemis co., 193 USPQ 8.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-53 have been considered but are moot in view of the new ground(s) of rejection.

***Contact Information***

11 Any correspondence to this action may be mailed to:

**Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad whose telephone number is (571) 272-2099.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor can be reached at (571) 272-2800 ext 39. The fax number is (703) 872-9306.



Chandrika Prasad  
Primary examiner  
February 24, 2006